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10/627,873	07/28/2003	Steven M.H. Wallman	10392/460041	3618

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EXAMINER	
MEINECKE DIAZ, SUSANNA M	
ART UNIT	PAPER NUMBER
3692	

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03/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/627,873	WALLMAN, STEVEN M.H.	
	Examiner	Art Unit	
	Susanna M. Diaz	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) *1 and 3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/14/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed December 10, 2007.

Claim 2 has been amended. Claims 1 and 3 stand as withdrawn.

Claim 2 is presented for examination.

Response to Amendment

2. The previously pending objections to the specification are withdrawn in response to Applicant's amendments to the specification.

Response to Arguments

3. Applicant's arguments filed December 10, 2007 have been fully considered but they are not persuasive.

Applicant argues that "systems such as the Lupien system do not permit trading orders that include fractional shares or odd lots, which would be considered economically unviable…In short, Lupien et al. fails to disclose anything regarding the execution or trading of economically unviable trades." (Page 7 of Applicant's response) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., fractional shares or odd lots, which would be considered economically unviable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's broad challenge of Official Notice (on page 6 of Applicant's response) is deemed to be an improper challenge since Applicant does not explain why the Official Notice is allegedly inaccurate. Applicant appears to be arguing the motivation to combine Lupien with the Official Notice teachings instead; however, Applicant's assertions rely on the improper assumption that economically unviable trades refer to trading orders that include fractional shares or odd lots (which is not claimed). The Examiner interpreted economically unviable orders to include, for example, trading orders that would not be completed because of a poor credit rating or simply the inability to pay money owed in association with a trade. For example, Silverman (U.S. Patent No. 5,924,082) assesses the viability of a trading arrangement based on the trading parties' credit risk, which may include a likelihood of a trading party to go into bankruptcy before the trade transaction is complete (abstract; col. 2, lines 41-67).

In conclusion, Applicant's arguments are non-persuasive and the art rejection is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (U.S. Patent No. 5,845,266).

Lupien discloses a system for creating a portfolio of assets and executing trades in the assets to modify the portfolio, comprising:

[Claim 2] a) a first processor interfaced with an investor's PC to select a plurality of assets to be in the investor's portfolio based on the investor's indicated preferences, to manage the portfolio in accordance with market changes and changes in the investor's indicated preferences, and to electronically place at least one trading order in accordance with the investor's indicated preferences (Figs. 2, 6, 7; col. 6, lines 29-39; col. 7, lines 30-47; col. 16, lines 25-29; col. 17, line 31 through col. 18, line 32 – The trader's buy and sell baskets should be kept balanced. A trader's preference to become more or less aggressive about buying/selling a given security may change based on the execution status of other securities in the trader's actual/desired basket; col. 19, lines 23-26);

b) a communication interface coupled to the processor and coupled to a plurality of other investors by which the processor electronically places the at least one order (col. 6, lines 29-39; col. 19, lines 23-26); and

c) a central processor coupled to the communication interface, receiving a plurality of trading orders from among the plurality of investor's PC's, including at least one economically unviable trading order, and electronically forwarding the aggregated trading orders for execution to a third party (Figs. 4, 6, 7; col. 6, lines 29-39; col. 11,

lines 1-16; col. 14, lines 5-62 – A price and/or size limit or match of a trade may make or break the potential trade; col. 19, lines 23-26).

As per claim 2, Lupien states, "The CMC 2 can be coupled to an automated clearing system and/or accounting system. Orders that are matched can then be automatically output to such system(s) to assist in 'backoffice' procedures." (Col. 19, lines 23-26) Lupien does not expressly disclose that all received trading orders [which include at least one economically unviable trading order] are aggregated into a single order for each asset among the received trading orders; however, Lupien does send the matched orders to an automated clearing system and/or accounting system. Official Notice is taken that it was old and well-known in the art of finance at the time of Applicant's invention to approve or disapprove a transaction through an accounting system. Those of ordinary skill in the art at the time of Applicant's invention would have predicted that, if the accounting system determines that a particular trading order is economically unviable, then the trading order would likely not be approved (thereby preventing loss of profit to the party that would be owed money as part of the proposed trading order). Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Lupien such that all received trading orders [which include at least one economically unviable trading order] are aggregated into a single order for each asset among the received trading orders in order to take advantage of Lupien's accounting system to determine that a particular trading order is economically unviable so that the trading order would likely

not be approved (thereby preventing loss of profit to the party that would be owed money as part of the proposed trading order).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-86 of U.S. Patent No. 6,601,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the instant application is fully anticipated by the claims of the patent. Elimination of an element or its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions (see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)).

8. Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,996,539. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the instant application is fully anticipated by the claims of the patent. Elimination of an element or its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions (see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692
March 19, 2008